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EXAMINER

HAILU, TADESSE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2173

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/580,904

Applicant(s)

SHAFRIR ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response to the Amendment entered on December 6, 2004.
2. The patent application claims priority from domestic US Application 60/137,513 filed June 2, 1999.
3. The pending claims 1-33 are examined herein as follows.

### Claim Rejections - 35 U.S. C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-33 are rejected under 35 U.S.C 103(a) as being unpatentable over Mirabilis LTD. Quick Tour. February 12, 1998 in view of ICO Inc. ICO Email Signature, May 2 1999.

ICQ, as described and illustrated in Mirabilis LTD, Quick Tour, is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact them by clicking the name or the icon next to it and then send a message, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence

(on-line status indicator) to those whose list (contact list) you are on and notifies you if your contacts are on-line (status indicator) as well. This status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on.

Moreover, as described below, it is clear that the current claims are not distinguishable over the cited art.

Per claim 1:

As per "status determining means," ICQ, as describes and illustrates in Quick Tour, does provide plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on the Internet (Quick Tour, page 5).

As per "status indicator presenting means," as mentioned above, ICQ, as describes and illustrates in Quick Tour, provides the status indicator (such as online or offline) and also provides user indicators (such as names or IDs) associated with the status indicators. By clicking or selecting the indicator one can establish communication with other users with a selected communication mode (Quick Tour, pages 5-6).

As per "user indicator presentation means," ICQ, as described and illustrated in Quick Tour, does teach a user indicator presentation means, such as name, ICQ's unique ID number, etc that are associated with the user (Quick Tour, pages 1-3). As mentioned above any one of these indicators allows you to connect or link to others by clicking on the indicator (Quick Tour, pages 1-3).

Although ICQ describes user indicator presentation means, but ICQ does not expressly describe "enabling presentation of one ore more user indicators within the two

or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one network user.”

ICQ Inc, ICQ Email Signature describes these shortcomings. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Furthermore, Quick Tour in view of ICO Email Signature further discloses that the status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with user indicator (see Quick Tour, pages 5-6

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature to the previous version of ICQ (How to Use ICQ because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

Per claims 6, 13, 18, and 26-29:

The remaining independent claims, 6, 13, 18, 26-29 are rejected for the same reason given to claim 1.

Per claims 2, 4, 14, 16, and 19:

ICQ provides a status indicator such as a flower symbol which changes color (color-coded) based on the user's status (Quick Tour, page 4).

Per claims 3, 8, 15, and 20:

ICQ further discloses status indicators displayed in a menu (Quick Tour, page 5).

Per claims 5, and 17:

As illustrated in page 5, the user indicator is selected by selecting the status indicator icon for the selected user (Quick Tour, pages 4-5).

Per claim 7:

As illustrated in page 5, symbol icon is used to indicate the status indicator of a user (Quick Tour, pages 4-5).

Per claims 9, and 21:

The status indicators includes color-coding, that is, the symbol (flower icon) changes to green to announce your presence to those whose list you are on. (See Quick Tour, pages 4-5).

Per claims 10, 12, 22-25:

ICQ, as mentioned above, does provide several communication preference to a user, such preference include, e-mail, chat, send message files and URLs, play games, draw on whiteboards, communicate through voice while surfing the net (see page 6). User can initiate or establish any one of the communication modes to communicate and share at least one application with one or more users (Quick Tour, page 6).

Per claim 11:

ICQ user is able to establish or initiate one or more communications such as using ICQ's voice, or data sharing applications with one or more network users (Quick Tour, page 6).

Per claims 30 and 31:

ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Per claim 32:

In addition to the limitations recited in system claim 1, the system of claim 32, further recites a user directory (which is similar to Quick Tour in view of Email Signature, contact information) that includes user information and the user information further includes user indicators as described and illustrated in ICQ (Quick Tour in view of Email Signature, see Quick Tour, pages 5-6). Claim 32 further recites document generated by two or more applications (which is similar to Quick Tour in view of Email Signature e-mail document, chat document, web document, etc, see Quick Tour). The document further includes at least two user depictions associated with at least two network users (which is similar to Quick Tour in view of Email Signature user indicator icon, see Quick Tour). Claim 32 further recites an identification-determining module (which is similar to Quick Tour in view of Email Signature name, ICQ number or contact information, see Quick Tour).

Per claim 33:

In addition to the limitations recited in system claim 1, the system of claim 33, further recites document generated by two or more applications (which is similar to Quick Tour in view of Email Signature e-mail document, chat document, web document, etc) and each of the documents includes a plurality of fields (which is similar to Quick Tour in view of Email Signature name, address, etc fields, see Quick Tour).

### ***Response to Arguments***

6. Applicant's arguments filed on December 6, 2004 have been fully considered but they are not persuasive.

Applicant submit a copy of a portion of the homepage of the Wayback Machine website. Applicant further states that the archive data is only represented by the Wayback Machine as being accurate for the homepage, and not for other archived pages linked thereto. The Examiner disagrees each complete URL pages has its own corresponding posting date. For example, one of the references cited ("How to Use ICQ") has a complete URL name <http://web.archive.org/web/19980212181102/www.icq.com/icqtour/fulltour.html>, wherein the posting date is 2/12/98. Similarly, the ICQ Email Signature has its own complete URL name, that is,

<http://www.archive.org/web/19990502092623/9cq.com/emailsig.html>, wherein the posting date is 5/2/1999. While the Applicant does not argue the publishing date of "How to Use ICQ", but the Applicant argues for the ICQ Email Signature publication date. The examiner would like to indicate the Applicant by entering any one of the above URL, one can only reach to a designated particular page not to a home page as



applicant suggested. Therefore, the publication date relied upon by the Examiner for ICQ Email Signature is correct.

Applicant also argues the ICQ Email signature also does not suggest this feature (user indicators) because ICQ Email Signature requires a user to enter ICQ# so that the user's status may be tracked by the status indicator included in the email signature block. The Examiner disagrees entering ICQ # is not the only means to find out the user's status. Active or online user's status is shown automatically when the user logged to the system.

#### Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

8. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu  
12/19/2004

